



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,696	10/28/2005	Shuji Ozaki	14875-141US1 C1-A0220P-US	1270
26161 7590 04/23/2010 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER				
GUSLOW, ANNE				
ART UNIT		PAPER NUMBER		
1643				
NOTIFICATION DATE		DELIVERY MODE		
04/23/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/530,696

Applicant(s)

OZAKI ET AL.

Examiner

Anne M. Gussow

Art Unit

1643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 13-25, 28, 31-38 and 42-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 13-23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24, 25, 28 and 32-34 is/are allowed.
- 6) ☒ Claim(s) 31, 35-38 and 42-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-944)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :11/30/09, 12/11/09, 12/31/09, 1/15/09, 4/14/10.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 30, 2009 has been entered.

2. Claims 24 and 35 have been amended.

Claims 7-12, 26, 27, 29, 30, and 39-41 have been cancelled.

Claims 1-6 and 13-23 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 16, 2006.

3. Claims 24, 25, 28, 31-38, and 42-45 are under examination.

4. The following office action contains NEW GROUNDS of Rejection.

Rejections Withdrawn

5. The rejection of claims under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of applicant's arguments.

Information Disclosure Statement

6. The information disclosure statements (IDS) submitted on November 30, 2009, December 11, 2009, December 31, 2009, January 15, 2010, February 22, 2010, and April 14, 2010 have been considered by the examiner and an initialed copy of the IDS is included with the mailing of this office action.
7. The proprietary information filed January 21, 2010 has been considered by the examiner.

NEW GROUNDS of Rejection

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 31, 35-38, and 42-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 31, 35-38, and 42-44 are indefinite for reciting "derived" in claims 31 and 35 because the exact meaning of the term is not clear. The term "derived" is not one,

which has a universally accepted meaning in the art nor is it one which has been adequately defined in the specification. The primary deficiency in the use of this phrase is the absence of an ascertainable meaning for said phrase. Since it is unclear how the CDRs are to be derivatized from one or more antibodies to yield the class of derivatives referred to in the claims, there is no way for a person of skill in the art to ascribe a discrete and identifiable class of compounds to said phrase. In addition, since the term "derived" does not appear to be clearly defined in the specification, and the term can encompass amino acid substitutions, insertions, or deletions, chemically derivatized molecules, or even mimetics. In the absence of a single defined art recognized meaning for the phrase and lacking a definition of the term "derived" in the specification, one of skill in the art could not determine the metes and bounds of the claims.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29

USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 44 and 45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5 and 7 of copending Application No. 11/547747 (hereafter '747). Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a diabody that binds to HLA-A.

The instant claims recite an HLA-recognizing scFv or diabody produced by the method of claim 35. An HLA-recognizing minibody produced by the method of claim 24.

The '747 claims recite a minibody that binds to human leukocyte antigen class IA (HLA-A) and comprises a heavy chain variable region comprising CDRs 1, 2, and 3

that consist of the amino acid sequences of SEQ ID NOs: 13, 14, and 15, respectively, and a light chain variable region comprising CDRs 1, 2, and 3 that consist of the amino acid sequences of SEQ ID NOs: 16, 17, and 18, respectively, which is a diabody.

The '747 claims are a species of the genus of antibodies produced by a method of producing a minibody from a whole antibody. The instant claims define a minibody as a svFv or a diabody. Since both sets of claims bind to the same antigen and are a diabody the instant claims are anticipated by the '747 claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

12. Claims 31, 35-38, and 42-45 are rejected.

Claims 24, 25, 28, and 32-34 appear to be in condition for allowance.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne M. Gussow whose telephone number is (571)272-6047. The examiner can normally be reached on Monday - Friday 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Anne M. Gussow
April 19, 2010

/Anne M. Gussow/
Examiner, Art Unit 1643